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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,561	06/24/2002	Michael Mueller	1879	8818

7590 06/04/2003  
Striker Striker & Stenby  
103 East Neck Road  
Huntington, NY 11743

EXAMINER

SCHEUERMANN, DAVID W

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/980,561

**Applicant(s)**

MUELLER ET AL.

**Examiner**

David W. Scheuermann

**Art Unit**

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Objection to Product by Process Claims***

Claims 10 and 11 are objected to as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 11 are vague and indefinite because it is unclear whether the Applicant is claiming an apparatus or a method of making an apparatus. Base claim 1 indicates the invention is an apparatus, but these claims recite method of making limitations. In order to advance prosecution on the merits, the examiner has considered these claims as "product by process claims". As a product by a process claim "even though the product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. If the product in the product by process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process". *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966(Fed. Cir. 1985).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

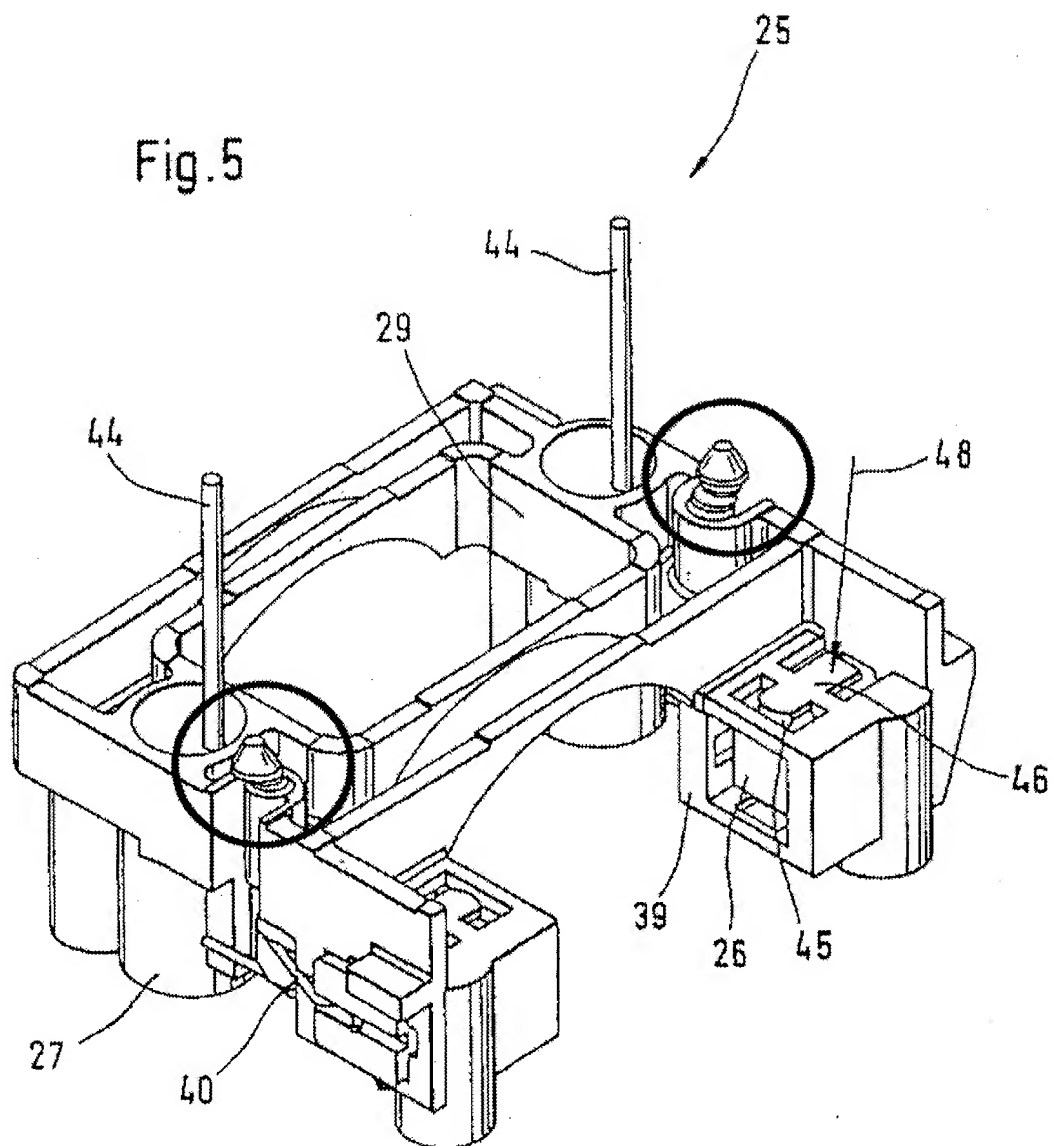
Claims 1-11 are rejected under 35 U.S.C. 102(a) as being anticipated by Klappenbach et al., US 6201326.

Klappenbach et al. show:

An actuator (1), in particular for an assembly of a motor vehicle,  
having a unit comprising an electric motor (3), a gear (5 and 6), and a motor electronics unit (30),  
having a housing (32 and 55 and 10), which comprises a gear housing (32) for the gear (6) and an electronics housing (32) for the motor electronics unit (30),  
having a motor housing (6) of the electric motor (3), which housing is connected to the housing (32),  
having a shaft (5) of the electric motor (3), which shaft protrudes into the gear housing (32),  
having a brush holder (25) in the housing (32),  
having a printed circuit board (32),  
\* which is disposed in the electronics housing (32),  
\* which is connected to an external connection plug (28),  
\* which is electrically connected to the brush holder (25) and to components of the motor electronics unit (37 and 38),

characterized in that

the brush holder (25), for installation in the actuator is loosely coupled to the printed circuit board (30).



Note in figure 5, shown above, the circled detents (circles added for clarification) capable of holding brush holder (25) "loosely" to circuit board (30). Alternately, electrical connections 44 protruding from brush holder (25) are introduced into openings in the printed circuit board (30) function to hold brush holder (25) "loosely" to circuit board (30).

Re claim 6, note figure 2 showing worm (5) encased by case (32) on one side and another case on the other side.

As to claim 9, note the paragraph bridging columns 4 and 5 provides for elastic prestressing of the brush holder (25), consequently abutting circuit board (30) is also supported thereby.

Claims 10 and 11 include method steps. These steps do not patently define over the apparatus of Klappenbach et al. as described in the objection to these claims above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moskab shows brush carrying plate 17a in figure 3 loosely connected to circuit board 41. Kimure et al. show bent fingers used to fix a brush holder to a circuit board. Kikly teaches making a releasably attached brush retainer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David W. Scheuermann whose telephone number is (703) 308-9637. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308-1371. The fax phone

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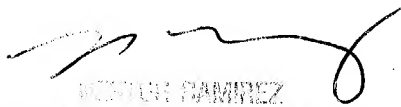
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numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

dws

May 28, 2003

  
DENISE SAMIREZ  
SUPERVISOR, PATENT EXAMINER  
MAY 28 2003